

REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested. Applicant has amended claims 1, 7, 10, 11, 20, and canceled claim 9 in order to clarify the subject inventions differences from Cox ('319). No new matter nor new consideration is being raised with this response, applicant's amendments are directed to including language in existing dependent claims, and clarifying terms in the claims. Favorable reconsideration of this application, consequently, is earnestly solicited in view of the following remarks. Applicant gratefully appreciates the telephone consultation with the Examiner on April 14, 2004.

As to the objection to the claims, applicant notes that other related cases pending before the examiner, for example, U.S. Application Serial Number 09/805,064 recite the use of (a(i), a(ii), and the like), and have not been objected to. Applicant's amendment to the claims should also have obviated this objection.

Claims 1-20 were rejected under sec. 102e as being anticipated or under sec. 103 as being obvious over Cox et al. '319. Applicant has amended independent claims 1, 11 and 20 to more clearly clarify that "determining if the detected signal is a continuous noise signal over a first time period or is a period of silence over a second time period, the first time period being different from the second time period....." Claim 1 was amended to include the novel subject matter of dependent claim 7. Independent claims 11 and 20 were amended to only clarify that the subject invention novel features of being able to dually determine if either condition exists.

As previously noted Cox '319 is NOT capable of determining both conditions. Furthermore, applicant notes that the same Cox '319 reference was cited by the parent application 09/124,697 to the subject application which matured into U.S. Patent 6,324,262. Applicant has also amended independent claims 1, 11 and 20 to more clearly clarify that the "message" is "delivered in a nontruncated form..." which applicant believes was encompassed by the previous language in the claims, and which is also clearly encompassed by at least page 1, lines 4-9, of the specification. Furthermore, this language was also in the allowed claims of the the parent application 09/124,697 to the subject application which matured into U.S. Patent 6,324,262. Again, the parent patent clearly referred to the Cox '319 reference.

MPEP section 706.04 states that full faith and credit should be given to the action of a previous examiner unless there is clear error in the previous action or knowledge of other prior art. The examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner in mere hopes of finding something. *Amgen Inc. v. Hoechst Marion Roussel, Inc.* 126 F. Supp. 2d 69, 139, 57 USPQ 2d 1449(D-Mass 2001).

The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).


Applicant contends the references cannot be modified to incorporate the features of subject claims 1, 2, 8, 12-16 and 19-26 without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In view of the foregoing considerations, it is respectfully urged that the subject amendment be entered and claims 1-8, and 10-20 be allowed. Such action is respectfully requested. Alternatively, applicant requests that the subject amendment be entered, and a new nonfinal office action be issued to address the fact that the Examiner using the Cox '319 reference which the previous examiner in the parent application has found to be overcome. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Date

7/19/04

Respectfully Submitted,


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